

**REMARKS**

Applicants respectfully contend that the finality of the present office action mailed 09/29/2005 is improper under MPEP 706.07(a) as discussed *infra*.

The Examiner withdrew claims 25-26 as allegedly being directed to a non-elected invention such that Applicants have constructively elected the originally presented invention for which Applicants have received an action on the merits.

The Examiner rejected claims 1-2, 5-8, 10-12, 15-18, and 20-24 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe *et al.* (hereinafter Pepe), US 5,673,322, in view of Gauvin *et al.* (hereinafter Gauvin), US 5,790,800 and Gordon *et al.* (hereinafter Gordon), US 6,671,729.

The Examiner rejected claims 3 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin, and Gordon as applied to claim 1 and 11 above, and further in view of Batra, US 6,105,067.

The Examiner rejected claims 4 and 14 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin, and Gordon as applied to claims 1 and 11, and further in view of van Landegem *et al.* (hereinafter van Landegem), US 5,265,091.

The Examiner rejected claims 9 and 19 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin and Gordon as applied to claim 18 above, and further in view of O'Connell *et al.* (hereinafter O'Connell), US 6,661,787.

Applicants respectfully traverse the finality of the present office action, the withdrawal of claims 25-26, and the §103(a) rejections with the following arguments.

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**Finality of the Present Office Action**

Applicants respectfully contend that the finality of the present office action mailed 09/29/2005 is improper under MPEP 706.07(a) because the Examiner introduced new grounds of rejection not necessitated by Applicants' response (filed 08/15/2005) to the office action mailed 06/17/2005. The Examiner explicitly states: "Applicant's amendment filed on 8/15/2005 necessitated the new ground(s) of *rejection* presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**" Applicants maintain that Applicants did not amend claims 1-2, 5-8, 10-12, and 15 in Applicants' response filed 08/15/2005. Yet, the present office action has rejected claims 1-2, 5-8, 10-12, and 15 on new grounds, namely on grounds that claims 1-2, 5-8, 10-12, and 15 are allegedly unpatentable under 35 U.S.C. §103(a) over *Pepe et al.* (USP 5,673,322), in view of *Gauvin et al.* (USP 5,790,800) and *Gordon et al.* (USP 6,671,729).

Applicants additionally contend that the new grounds of rejection was necessitated by the Examiner's realization that the Examiner had erroneously rejected claims 1-2, 5-8, 10-12, and 15 on improper grounds, namely on grounds of 35 U.S.C. §103(a) over *Pepe et al.* (USP 5,673,322), in view of *Gauvin et al.* (USP 5,790,800) and *Banaver* (USP 6,662,067). As stated in the Examiner's Interview Summary for a telephonic interview held on 09/13/2005, "Examiner admits that the Banaver reference is a commonly assigned patent owned by IBM and hence is not a valid 103 a reference ...." Since the new grounds of rejection was necessitated by the Examiner's erroneous use of the Banaver reference, and not by amendment of claims 1-2, 5-8, 10-12, and 15 in Applicants' office action response filed 05/31/2005, the finality of the present office action is improper.

Accordingly, Applicants respectfully request that the office action mailed 09/29/2005 be

changed from a final office action to a non-final office action.

**Withdrawal of Claims 25-26**

The Examiner withdrew claims 25-26 as allegedly being directed to a non-elected invention such that Applicants have constructively elected the originally presented invention for which Applicants have received an action on the merits.

However, in order for claims 25-26 to be considered as a non-elected invention in accordance with MPEP 821.03 and 37 CFR 1.145, claims 25-26 must be "directed to an invention distinct from and independent of the invention previously claimed". When an Examiner issues a restriction, the Examiner provides arguments supporting the restriction. In contrast, the Examiner has not offered reasons to demonstrate that claims 25-26 are "directed to an invention distinct from and independent of the invention previously claimed". In fact, the Examiner has not even alleged that claims 25-26 are "directed to an invention distinct from and independent of the invention previously claimed". Applicants respectfully contend that the Examiner has a burden to justify the constructive election based on 25-26 are "directed to an invention distinct from and independent of the invention previously claimed" (which the Examiner has not done), after which Applicants can review and assess the Examiner's arguments. Accordingly, Applicants respectfully contend that the Examiner has improperly issued a constructive election of the originally presented invention and has improperly withdrawn claims 25-26.

In addition, Applicants note that the pending claims prior to adding new claims 25-26 are claiming a novel intercept technology. New claims 25-26 are claiming an embodiment comprising a SOCK and a SOCKS protocol, using the same novel intercept technology. Thus, Applicants maintain that claims 25-26 would not have been subject to a restriction had claims

25-26 been originally presented. Therefore, the Examiner is not justified in issuing a constructive election of the originally presented invention and has improperly withdrawn claims 25-26.

Based on the preceding arguments, Applicants respectfully request reconsideration, under 37 CFR 1.143, of the constructive election of the originally presented invention and the withdrawal of claims 25-26.

**35 U.S.C. §103(a)**

The Examiner rejected claims 1-2, 5-8, 10-12, 15-18, and 20-24 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe *et al.* (hereinafter Pepe), US 5,673,322, in view of Gauvin *et al.* (hereinafter Gauvin), US 5,790,800 and Gordon *et al.* (hereinafter Gordon), US 6,671,729.

Since claims 10 and 20-24 have been canceled, the rejection of claims 10 and 20-24 is moot.

**Claims 1-2, 5-8, 11-12, and 15-18**

Applicants respectfully contend that claims 1 and 11 are not unpatentable over Pepe in view of Gauvin and Gordon, because Pepe in view of Gauvin and Gordon does not teach or suggest each and every feature of claims 1 and 11.

As a first example of why claims 1 and 11 are not unpatentable over Pepe in view of Gauvin and Gordon, Pepe in view of Gauvin and Gordon does not teach or suggest the feature: "intercepting, by a client interceptor acting on behalf of a server application, a second-protocol data communication request from a client application" (claim 1) and "a client interceptor acting on behalf of the server application, said client interceptor adapted to intercept a second-protocol data communication request from the client application" (claim 11).

The Examiner argues: "Pepe did not specifically teach that the local proxy is a client interceptor, the remote proxy is the server interceptor the condition in response to said ascertaining. However, it is obvious that since the proxies function to intercept requests, they

present the functionalities and abilities of acting or being interceptors. Gauvin taught to use interceptors in intercepting the requests (col.2, lines 38-42, col.9, lines 5-7, col.12, lines 57-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Pepe and Gauvin because Gauvin's teaching of using interceptors help to implement the proxies of Pepe's method to intercept requests and establish communications (Gauvin, col. 12, lines 57-63)."

In response, Applicants respectfully contend that the Examiner's reason for modifying Pepe to incorporate Gauvin's alleged teaching of interception is not supported in Pepe or in Gauvin as explained next. The Examiner's reason for modifying Pepe by Gauvin's alleged teaching is "to implement the proxies of Pepe's method to intercept requests and establish communications".

With respect to Pepe, Applicants find the preceding argument by the Examiner to be non-persuasive, since Pepe already discloses a simple and efficient method of implementing communication between the client's browser and the remote proxy via use of a local proxy (see Pete, col. 7, line 66 - col. 8, line 33), and the Examiner has not provided any argument as to why use of the local proxy as an interceptor would as efficient as, or more efficient than, Pepe's disclosed manner of using of the local proxy.

With respect to Gauvin, Applicants note that Gauvin, col. 8, line 66 - col. 9, line 7 recites: "A problem exists. The prior art software processes and data structures necessary to establish and maintain a communication circuit between the client applications 210 and a servers 111-113 assume that the circuit 131 is extant. However, for mobile client applications 210 making a request of the servers 111-113, this may not be true. Therefore, the present invention, as a

solution provides for the interception of client application requests. The requests are intercepted by the interceptor 700." Thus, Gauvin teaches interception of client requests to account for the possibility that circuit 131 in FIG. 1 of Gauvin may not be extant. However, there is no teaching in Pepe of the possibility of a circuit, such as Gauvin's circuit 131, as not being extant. Therefore, the motivation for teaching interception of client requests in Gauvin does not carry over to Pepe.

Thus, Applicants contend that the Examiner has not cited any suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to modify Pepe by the alleged teaching of Gauvin in a way that would produce the claimed invention of claims 1 and 11.

As a second example of why claims 1 and 11 are not unpatentable over Pepe in view of Gauvin and Gordon, Pepe in view of Gauvin and Gordon does not teach or suggest the feature: "compensating a disadvantageous characteristic of the first protocol, said compensating comprising ascertaining that a condition exists and eliminating the condition in response to said ascertaining, said condition being a connection condition or a transmission capacity condition" (claim 1) and "means for compensating a disadvantageous characteristic of the first protocol, said compensating comprising ascertaining that a condition exists and eliminating the condition in response to said ascertaining, said condition being a connection condition or a transmission capacity condition" (claim 11).

The Examiner argues: "Gordon taught to detect that a condition exists and eliminate the condition in response to said detection (col.6, lines 62-67, col.7, lines 1-22; known technique for



detecting lost connection and re-establishing connection). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Pepe, Gauvin and Gordon because Gordon's teaching of determining broken connections and reestablishing connections enables Pepe and Gauvin's method to monitor connections and re-establish the lost connections."

In response, Applicants respectfully contend that the Examiner's argument as to why it is allegedly obvious to combine the teachings of Pepe, Gauvin and Gordon is based on **circular reasoning** and is therefore not persuasive. The Examiner is arguing that it is obvious to detect a lost connection and re-establish the lost connection in order to monitor the connection and re-establish the lost connection, which is circular reasoning..

Based on the preceding arguments, Applicants respectfully maintain that claims 1 and 11 are not unpatentable over Pepe in view of Gauvin and Gordon, and that claims 1 and 11 are in condition for allowance. Since claims 2-8 depend from claim 1, Applicants contend that claims 2-8 are likewise in condition for allowance. Since claims 12 and 15-18 depend from claim 11, Applicants contend that claims 12 and 15-18 are likewise in condition for allowance.

#### Claims 3 and 13

The Examiner rejected claims 3 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin, and Gordon as applied to claim 1 and 11 above, and further in view of Batra, US 6,105,067.

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Since claims 3 and 13 respectively depend from claims 1 and 11, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin and further in view of Gordon under 35 U.S.C. §103(a), Applicants maintain that claims 3 and 13 are likewise not unpatentable over Pepe, Gauvin, and Gordon, and further in view of Batra under 35 U.S.C. §103(a).

#### Claims 4 and 14

The Examiner rejected claims 4 and 14 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin, and Gordon as applied to claims 1 and 11, and further in view of van Landegem *et al.* (hereinafter van Landegem), US 5,265,091.

Since claims 4 and 14 respectively depend from claims 1 and 11, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin and further in view of Gordon under 35 U.S.C. §103(a), Applicants maintain that claims 4 and 14 are likewise not unpatentable over Pepe, Gauvin, and Gordon and further in view of Landegem under 35 U.S.C. §103(a).

In addition, Pepe, Gauvin, and Gordon and further in view of Landegem does not teach or suggest the feature: “wherein the ascertaining comprises determining that transmission capacity is insufficient to process the data communication request **within a predetermined interval of time**, and wherein the eliminating comprises establishing a parallel connection to increase transmission capacity” (emphasis added).

The Examiner argues: “As per claims 4 and 14, Pepe, Gauvin, and Gordon taught the invention substantially as claimed in claims 1 and 11. Pepe further taught wherein the act of compensating further comprises the acts of determining that transmission capacity is insufficient

process the data communication request (col.9, lines 26-32). Pepe, Gauvin, and Banavar did not specifically teach herein the act of compensating further comprises the acts of determining the transmission capacity to process the data communication request within a predetermined interval of time, and establishing a parallel connection to increase transmission capacity. van Landegem taught to determine the transmission capacity with a predetermined interval of time and to establish a parallel connection to increase transmission capacity (col.12, lines 15-40, 52-63, col. 14, lines 54-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Pepe, Gauvin and van Landegem because van Landegem's teaching of determining transmission capacity and establishing parallel connection helps Pepe and Gauvin's method to determine bandwidth availability in a periodic basis in a connectionless environment (e.g., first protocol, col.2, lines 14-19)".

In response, Applicants respectfully contend that Landegem (col.12, lines 15-40, 52-63, col. 14, lines 54-61) does not teach or suggest "determining the transmission capacity to process the data communication request **within a predetermined interval of time**". Applicants contend that the "predetermined interval of time" taught by Landegem to determine transmission capacity (i.e., bandwidth ) is not the "predetermined interval of time" recited in claims 4 and 14. In fact, any given "predetermined interval of time" can be used to calculate the bandwidth, simply by dividing the given "predetermined interval of time" by the cell count (see Landegem, col. 12, lines 29-38). In contrast, the "predetermined interval of time" recited in claims 4 and 14 is being used to determine whether the transmission capacity is sufficient to process the data communication request of claims 4 and 12.

For example, assume that the data communication request is required to be processed in 2

seconds and that processing the data communication request requires transmitting 10,000 bytes of data. For this example, a transmission capacity of 5,000 bytes/sec is required to process the data communication request in a predetermined interval of time of 2 seconds. In order to determine whether the actual transmission capacity is sufficient for this purpose (as is required in claims 4 and 14), one must compare the actual transmission capacity with the required transmission capacity of 5,000 bytes/sec. Therefore, one must know the actual transmission capacity. Landegem teaches using a predetermined interval of time to calculate the actual transmission capacity. Thus, the predetermined interval of time (e.g., 10 seconds, 60 seconds, etc.) used to calculate the actual transmission capacity is unrelated to the "predetermined interval of time" of claims 4 and 14.

The point is that the "predetermined interval of time" taught by Landegem relates to calculating the actual transmission capacity, whereas the "predetermined interval of time" in claims 4 and 14 relates to determining whether the actual transmission capacity is sufficient for satisfying the predetermined data transmission capacity requirement (i.e., 5000 bytes/sec in this example) for processing the data communication request of claims 4 and 14.

Accordingly, Applicants respectfully contend that the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 4 and 14.

#### Claims 9 and 19

The Examiner rejected claims 9 and 19 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin and Gordon as applied to claim 18 above, and further in view of O'Connell *et al.* (hereinafter O'Connell), US 6,661,787.

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Since claims 9 and 19 respectively depend from claims 1 and 11, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin and further in view of Gordon under 35 U.S.C. §103(a), Applicants maintain that claims 9 and 19 are likewise not unpatentable over Pepe, Gauvin, and Gordon and further in view of O'Connell under 35 U.S.C. §103(a).

In addition, Pepe in view of Gauvin and further in view of O'Connell does not teach or suggest the feature: receiving, by the client interceptor, an identification of the server application" (claim 9); and "means for receiving, by the client interceptor, an identification of the server application" (claim 19).

The Examiner alleges that Gauvin teaches the preceding feature of claims 9 and 19 in col. 9, lines 61-67; col. 10, lines 1-19.

Applicants cite Gauvin, col. 10, lines 15-16 which states that "... port and server identifications, are provided in step 820". Moreover, Gauvin, col. 10, lines 8-11 teaches that the interceptor intercepts the execution flow of steps 810, 820-850. Thus, the interceptor in Gauvin executes step 820. Applicants note that step 820 recites "providing" server identifications. Thus, by executing step 820, the interceptor executes "providing" server identifications. However, claims 4 and 14 require "receiving" a server identification. Applicants maintain that "providing" a server identification is the exact opposite of "receiving" a server identification. Therefore, Gauvin does not disclose the preceding feature of claims 9 and 19.

In addition, Applicants respectfully maintain that the Examiner's argument with respect to O'Connell is an improper modification of the secondary reference of Gauvin. The Examiner argues that the primary reference of Pepe discloses most of the features of claim 9 and 19. The Examiner also argues that the secondary reference of Gauvin has modified the primary reference

of Pepe, by alleging that Gauvin teaches or suggests "receiving ... an **identification** of the server application" (emphasis added). The Examiner additionally argues that the secondary reference of O'Connell has modified the secondary reference of Gauvin, by alleging that O'Connell teaches or suggests "forwarding the **identification** to an address-resolution server ..." (emphasis added). Applicants maintain that it is improper to argue that a claim feature is taught or suggested by a secondary reference through modification of another secondary reference. If the Examiner could modify a secondary reference in the preceding manner, then the Examiner would be able to show the existence of any element or feature of any claim merely by chaining a sufficient number of secondary references together in the preceding manner. Accordingly, Applicants respectfully maintain that the rejection of claims 9 and 19 under 35 U.S.C. §103(a) is improper and should be withdrawn.

**CONCLUSION**

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457.

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